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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/972,313	11/18/97	PICKENS	T

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MM51/1127

EXAMINER

TREMBLAY, M

ART UNIT PAPER NUMBER

2876

DATE MAILED: 11/27/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/972,313

Applicant(s)

Pickens

Examiner

M. Trumbly

Group Art Unit

2876

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-27 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

Serial Number: 08/972,313

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Applicant: Thomas Boone Pickens III

Filing date: 11/18/97

Part III Action on the Merits

Claim Objections

Claim 6 is objected to because of the following informalities: the claim should probably read "detachably connected" . Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a two dimensional code as claimed in claim 10, does not reasonably provide enablement for a "multi-dimensional" code. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claim encompasses 3 dimensional codes and higher. No example is given in the specification, and no well accepted definition exists within the art to account for this language. There is no reason to use this language unless some higher number of dimensions than two is contemplated, and the claim must be interpreted this way.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "... the size of the text" lacks antecedent basis. It is unclear what this limitation means, since not only is text not referred to in claim 1, its size is not specified.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-6, 9, 14, 15, drawn to an optical scanning system, and claims 16-18, 20, 25-27 drawn to an optical scanning method are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #5,804,803 to Cragun et al. ("Cragun" hereinafter). Cragun discloses an optical scanning system for scanning graphical codes 117 on an object 115 to obtain the encoded Internet address for the object comprising:

an object 115 comprising at least one graphical code 117 displayed on the object, the graphical code further comprising an encoded Internet address (URL-- see e.g. column 4, lines 35-40);

scanning means 118 for optically scanning the graphical code; and
a computer 102 connected to the scanning means and further comprising processing means 104 for decoding the scanned encoded Internet address.

Re claim 2, see 120 in figure 1A.

Re claim 3, a wireless network device such as the AIRONNET 2.4 GHz spectrum transceiver (column 3, line 52) contains a modulator and demodulator, or modem.

Re claim 5, a scanner is inherently "detachable" from the computer, unless it is the computer. In Cragun, it is not.

Re claim 13, note that the bar code on the top of the Cragun patent is approximately 7mm high. Smaller bar code heights are old and well known.

Re claim 14, see figure 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the

obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5 Claims 7, 10-13, drawn to an optical scanning system, and claims 23-24, drawn to an optical scanning method are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #5,804,803 to Cragun et al. ("Cragun" hereinafter). Cragun discloses an optical scanning system as described above, but does not disclose a wireless infrared scanner. Official Notice is taken that wireless infrared scanners are old and well known in the art. See In Re Malcolm 1942
10 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use an infrared scanner as a substitute for the 2.4 GH scanner mentioned by Cragun because an infrared scanner performs substantially the same function (transceives data) in substantially the same way (without wires) to obtain substantially the same result (a person can walk around with the terminal, but still send and receive data to
15 another computer).

Re claim 12-13, 23-24 note that the bar code on the top of the Cragun patent is approximately 7mm high. Smaller bar code heights are old and well known.

Re claims 10-11, two dimensional codes are old and well known. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide
20 a two dimensional code instead of a one dimensional code because two dimensional codes can store more information, as was widely recognized in the art at the time the invention was made. Thus, for a long Internet address, the two dimensional code can store all the information in a small space (e.g. on a small consumer item).

25 Claims 8, drawn to an optical scanning system, and claims 19, 21-22 drawn to an optical scanning method are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #5,804,803 to Cragun et al. ("Cragun" hereinafter) in view of U.S. Patent #5,640,193 to Wellner ("Wellner" hereinafter). Cragun teaches the invention as described above, and further states that many different computer hardware and software configurations can be used to accomplish the
30 objectives of the disclosure. See column 5, lines 1-52. Wellner teaches that bar codes can be used

in a manner similar the URL in NCSA Mosaic, an Internet browser (see column 4, line 37). All that is required for a person of ordinary skill in the art is to buy a bar code "wedge" scanner (this type of scanner behaves exactly like a keyboard as far as the personal computer is concerned), and use it to scan in a URL written in Code 39 (for example-- code 39 fonts are available in WordPerfect and other popular word processing programs) when the cursor is positioned in the "Location" window of a browser. Cragun states that the disclosure applies to personal computers such as the Macintosh (column 5, line 37-38), and Wellner describes a similar system and its likeness to a Web browser. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a Web browser as described by Wellner to receive the URL described by Cragun, because the Web browser was recognized as the easiest method for accessing data on the Internet using a personal computer such as an Apple Macintosh.

Internet

PTO maintains an extensive web site at <http://www.uspto.gov>. Communications about this application via e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be addressed to **mark.tremblay@uspto.gov**. All Internet e-mail communications will be recorded in the application. PTO employees don't use the Internet to exchange sensitive information unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. For more details, see the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Voice

General inquiries or status inquiries about this application should be directed to the Group 2800 Receptionist at (703) 308-0956. Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 8:30 am to 6:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Don Hajec, can be reached on (703) 308-4075. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

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Fax Procedures

Application papers may faxed to Art Unit 2876 at (703) 308-7724. Faxes must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers solely for the examiner's consideration, and not intended for immediate entry into the application (e.g., a proposed amendment) should be unsigned and clearly marked "Draft Copy" and/or "Deliver Directly to Examiner."

MT

November 23, 1998


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